

PATENTABILITY ARGUMENTS

A. Response to 35 U.S.C. §102 (b) Rejections

In item 6 the Examiner objects to claims 1-4, 7 and 10-11 as being anticipated by U.S. patent 6,105,392 issued to Biagi under 35 USC §102 (b). For the Examiner to maintain a rejection under 35 U.S.C. §102(b) every element of Applicant's invention must be taught by the cited reference.

Regarding claim 1 the Examiner states that Biagi teaches an earring piercing and fastening system and method comprising a shaft 291 being mounted on a base, a connector 27 having a cavity 276 with means for engaging the shaft 274 and an adapter on the obverse 272 and a cap 28 having a means for affixing to the adapter on one side 281 into 272 and a decorative aspect of the earring attached on the obverse. Applicant respectfully disagrees.

Applicant has amended claim 1 to include the limitations that more clearly define the connector that now comprises a top surface and a bottom surface wherein the bottom surface fits flush against the pierced ear. In addition the amendments more clearly define the conformation of the adapter by specifying that the adapter projects from the top surface of the connector and finally the means for affixing the cap the adapter is more clearly defined as a cavity to receive the adapter.

In his rejection the Examiner states that Applicant's connector is identical to Biagi's element 26 of Figure 7. Applicant respectfully disagrees. In fact element 26 is neither identical nor does it perform the same function as Applicant's connector. More specifically, Biagi's element 26 is a device having a cylindrical shape so that it may be positioned within the body pierce and having threaded apertures 275/271 and 276/273 on either end to accept ornamental objects 28 and 29. The purpose of this device is for "affixing two ornamental objects into a body pierce simultaneously" (column 3 lines 6-7). After amending claim 1 it is now clear that Applicant's connector is not inserted into the body pierce, in fact it's bottom surface fits flush against the pierced ear but never enters the pierce. In addition, Applicant's connector is configured to accept an ornamental object affixed to the adapter on its top surface it does not have the capability of affixing an ornamental object on its bottom surface, which is flush against the ear. Consequently, Applicant's connector cannot be compared or equated to Biagi's element 27, it is neither similar nor identical to, nor does it perform the same function as element 27. Therefore, Biagi does not teach the connector of Applicant's invention and in view of this fact the Examiner's argument can no longer support a rejection of claim 1 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner

remove this rejection.

Regarding claim 2 the Examiner states that Biagi teaches an earring piercing and fastening system wherein the shaft comprises or is made of a hypoallergenic material. Based on the current claim amendments and in view of the argument presented above demonstrating that all limitations of claim 1 are not taught by Biagi the following argument can no longer support a rejection of claim 2 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

In Regards to claim 3 the Examiner states that Biagi teaches an earring piercing and fastening system wherein the shaft is grooved 291 and wherein the means for engaging the shaft is threaded in the cavity able to receive the threaded shaft 276. Based on the current claim amendments and in view of the argument presented above demonstrating that all limitations of claim 1 are not taught by Biagi the following argument can no longer support a rejection of claim 3 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

In regards to claim 4 Biagi teaches an erring piercing and fastening system wherein the shaft is grooved 291 and wherein the means for engaging the shaft are depressions 276 in the cavity that interlocks with the grooved shaft 291. Based on the current claim amendments and in view of the argument presented above demonstrating that all limitations of claim 1 are not taught by Biagi the following argument can no longer support a rejection of claim 4 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

In regards to claim 7 the Examiner states that Biagi teaches an earring piercing and fastening system wherein the means for affixing to the adapter is a clasping device 26 and 36 affixing to 281 and 381 respectively. Based on the current claim amendments and in view of the argument presented above demonstrating that all limitations of claim 1 are not taught by Biagi the following argument can no longer support a rejection of claim 7 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

In regards to claim 10 the Examiner states that Biagi teaches an earring piercing and fastening method comprising a shaft 291, the shaft having a base, a connector 27 having a cavity 276 with means for engaging the shaft 274 and an adapter on the obverse 272 and a cap 28 having means for affixing the adapter on one side and a decorative aspect of the earring on the obverse 281 comprising the steps of inserting the shaft through the pierced ear 105 having a front end and a back end 104 wherein the base is flush against the back of the ear and the shaft protrudes from the front of the ear; affixing the connector onto the shaft by inserting the shaft into the cavity wherein the adapter is positioned away from the front of the ear 276 and affixing the

cap to the adapter such that the decorative aspect is positioned away from the front of the ear 281 and 381 affixing 26 and 36 respectively.

Applicant has amended claim 10 to include the limitations that more clearly define the connector that now comprises a top surface and a bottom surface wherein the bottom surface fits flush against the pierced ear. In addition, the amendments more clearly define the conformation of the adapter by specifying that the adapter projects from the top surface of the connector and finally the means for affixing the cap the adapter is more clearly defined as a cavity to receive the adapter. Since the amendments to claim 1 and claim 10 are identical the arguments presented in claim 1 above are reiterated here and demonstrate that Biagi does not teach all limitations of claim 10. In view of these arguments and the amendments to claim 10 the Examiner's argument can no longer support a rejection of claim 10 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

In regards to claim 11 the Examiner states that Biagi teaches an earring piercing and fastening system comprising a plurality of shafts of different lengths 291 and 391, at least two connectors for engaging the plurality of shafts 26 and 36, each having an adapter 276 and 376 and a plurality of caps 218 and 381 for affixing the connectors having a decorative aspect on the obverse 281 and 381.

Applicant has amended claim 11 to include the limitations that more clearly define the structure of the shaft as having a base and the connector as comprising a top surface and a bottom surface wherein the bottom surface fits flush against the pierced ear. In addition, the amendments more clearly define the conformation of the adapter by specifying that the adapter projects from the top surface of the connector and finally the means for affixing the cap the adapter is more clearly defined as a cavity to receive the adapter. Since the amendments to claim 1 and claim 11 are essentially the same the arguments presented in claim 1 above are reiterated here and demonstrate that Biagi does not teach all limitations of claim 11. In view of these arguments and the amendments to claim 11 the Examiner's argument can no longer support a rejection of claim 10 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

Next the Examiner rejects claims 1 and 9 under 35 USC 102(b) as being anticipated by patent 5,743,113. In regards to claim 1 the Examiner states that Kogen teaches an earlobe piercing protector comprising a shaft 22 mounted on a base 26 a connector 30 having a cavity 38 with a means for engaging the shaft 28 into 38 and an adapter on the obverse 44 and a cap 32 having means for affixing on one side and a decorative aspect of the earring on the obverse 62. Applicant respectfully disagrees.

Applicant has amended claim 1 to include the limitations that more clearly define the

connector that now comprises a top surface and a bottom surface wherein the bottom surface fits flush against the pierced ear. In addition the amendments more clearly define the conformation of the adapter by specifying that the adapter projects from the top surface of the connector and finally the means for affixing the cap the adapter is more clearly defined as a cavity to receive the adapter.

In his rejection the Examiner states that Applicant's connector is identical to Kogen's element 30 of Figure 2. Applicant respectfully disagrees. In fact element 30 is neither identical nor does it perform the same function as Applicant's connector. More specifically, Kogen's element 30 is a flanged tubular member having an elongated rear portion 36 so that it may be positioned within the body pierce, an aperture 38 on one end to accept ornamental earring 22 and two annular grooves 44 and 46 to be received by central passageway 54 in clutch member 32. In use element 30 "is held by the user and its elongated rear end portion 36 is inserted from the front of the earlobe into the pierced opening 24C. When properly positioned the free end of the elongated rear portion 36 of the flanged tubular member 30 extends beyond the rear surface 24B of the earlobe." (column 4, lines 24-29) When in place element 30 is designed to protect the body pierce from irritation and or infection. After amending claim 1 it is now clear that Applicant's connector is not inserted into the body pierce, in fact it's bottom surface fits flush against the pierced ear but never enters the pierce. In addition, Applicant's connector is positioned on the front of and fits flush with the user's ear it does not extend through the pierce to the backside of the ear as is Krogen's element. Applicant's connector is configured to accept an ornamental object affixed to the adapter on its top surface unlike Krogen's device which is not capable of, nor discloses any reason for, affixing an ornamental object on the rear of the clutch member 32. In fact, Krogen applies the ornamental object on front surface 26A of post 28 while applicant's shaft comprises a base that does not receive an ornamental object and is positioned on the back of the ear. Consequently, Applicant's connector cannot be compared or equated to Krogen's element 30, it is not identical or similar to, it is not positioned on the ear in a similar or identical manner, nor does it perform the same function as element 30. Therefore, Krogen does not teach the connector of Applicant's invention and in view of this fact the Examiner's argument can no longer support a rejection of claim 1 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

In regards to claim 9 the Examiner states that Kogen teaches a pierced earlobe protector wherein the means for engaging having a flat head extending perpendicular from the obverse side of the connector and the cap having a keyhole-shaped slot capable of receiving the pin head 54 of cap receiving 46. Based on the current claim amendments and in view of the argument presented above demonstrating that all limitations of claim 1 are not taught by Krogen the following argument can no longer support a rejection of claim 9 based 35 USC 102(b). In view of this, Applicant

respectfully requests that the Examiner remove this rejection.

B. Response to 35 U.S.C. §103 (a) Rejections

The Examiner has rejected claims 5, 6 and 8 under 35 USC §103(a) as being unpatentable over Biagi in view of Indiveri *et al.* US patent 6,0305,192, Biagi in view of Schinzinger *et al.* U.S. patent 4,996,851 and Biagi in view of Float *et al.* U.S. Patent 5,893,278 respectively.

In regards to claim 5 the Examiner states that Biagi fails to teach a magnetic component connected via opposite magnetic charges. Indiveri *et al.* teaches an apparatus for increasing piercing safety whereby two components are connected together via the use of magnetic charges. In view of Applicant's amendments to claim 1 and arguments demonstrating that Biagi does not teach Applicant's connector The combination of the disclosure in Biagi with that of Iniveri *et al.* also do not teach Applicant's connector. Consequently, all of Applicant's claim limitations are not taught by the combined references and the Examiner can no longer support a rejection of claim 5 based on 35 USC §103(a). Therefore, Applicant respectfully requests that the Examiner remove this rejection.

In regards to claim 6 the Examiner states that Biagi fails to teach a connector segment comprising an adhesive. Schinzinger *et al.* teach a earring finding including a circular disc having a layer of adhesive covered with a strippable membrane. Applicant has cancelled claim 6 without prejudice consequently the Examiner's argument is moot. Applicant respectfully requests that the Examiner remove this rejection.

In regards to claim 8 the Examiner states that Biagi fails to teach a flexible component able to expand and retract to receive another component such as a connector. Float *et al.* teaches an assembly that has the ability to expand and retract around a stem of an earring. In view of Applicant's amendments to claim 1 and arguments demonstrating that Biagi does not teach Applicant's connector The combination of the disclosure in Biagi with that of Float *et al.* also do not teach Applicant's connector. Consequently, all of Applicant's claim limitations are not taught by the combined references and the Examiner can no longer support a rejection of claims 8 based on 35 USC §103(a). Therefore, Applicant respectfully requests that the Examiner remove this rejection.

REMARKS

C. Claim Amendments

Applicant has cancelled claims 5 and 6 without prejudice and added new claim 12

which is similar to claim 5 but in independent form.

Applicant has amended claim 1 and 10 by inserting the phrase "a top surface and a bottom surface" to more clearly define the surfaces of the connector, the phrase "that fits flush against said pierced ear on said bottom surface" to more clearly define the positioning of the connector, and the phrase "projecting from said top surface of the connector" to more clearly define the conformation of the adapter with respect to the top surface of the connector. In addition, Applicant has replace the phrase "means for affixing to" with the phrase "cavity to receive" to more clearly define the means for affixing.

Applicant has amended claim 11 by inserting the phrase "each of said shafts being mounted on a base" to more clearly define the structure of the shaft, the phrase "a cavity with means for engaging said shaft that fits flush against said pierced ear on said bottom surface and " to more clearly define the positioning of the connector, the phrase "each adapter projecting from said top surface of said connector" to more clearly define the conformation of the adapter, the phrase "each of said caps having a cavity to receive said adapter on one side" to more clearly define the means for affixing, the phrases "said cap" and "and" to comply with appropriate grammar. Applicant further replaced the phrase "for engaging said plurality of shafts" with the phrase "each of said connectors having a top surface and a bottom surface" to more clearly define the surfaces of the connector and deleted the phrase "each having" to comply with appropriate grammar.

The language defining the surfaces of the connector may be found on page 14, line 30 and 31 under the section titled "The Connector". The language defining the positioning of the connector can be found on page 14, line 31-32 and can be seen readily in Figure 4. The language defining the conformation of the adapter can be found on page 18, line 8. The language more clearly defining the means for affixing the cap to the adapter may be found on page 21, line 12.

Applicant has amended claim 9 replacing the word "engaging" with the word "affixing" as requested by the Examiner.

To the best of her knowledge Applicant believes that the amendments to the specification do not add new matter.

D. Response to Drawing Objections

In item 2, the Examiner objects to claim 6 because the adhesive described in the claim is not shown in any of the figures. Applicant has deleted claim 6, consequently the objection is moot and Applicant respectfully requests that the Examiner remove this

objection.

The Examiner further objects to claim 8 stating that Applicant has not shown in the figures where the adapter is a nipple and the means for affixing the adapter to the cap is a flexible component capable of expanding to receive the nipple. Applicant respectfully disagrees and directs the Examiner attention to figures 1D, E, F, and I. In Figures 1D-F the adapter is shown having a nipple as an adapter. Figure 1I has a compression spring within the cavity of the cap with having indented flexible components one on each side of the spring and directly opposite one another. These indented components expand to receive the nipple and then retract to grasp the nipple when the nipple is pressed into the cavity of the cap.

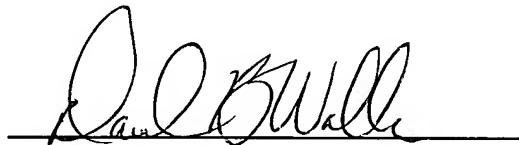
To the best of her knowledge Applicant believes that the amendments to the specification do not add new matter.

CONCLUSION

In view of the above arguments present Applicant has amended the claims and demonstrated that the invention as claimed satisfies the statutory requirements for patentability. Applicant's respectfully request that the Examiner issue an allowance of the claims.

Respectfully submitted,

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